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No. 06-353

IN THE

Supreme Court of the United States

ARLAINE & GINA ROCKEY, INC.,

Petitioner,

v.

CORDIS CORPORATION,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

A patent includes two fundamental elements, the specification and the claims. The specification describes how to practice the invention and includes various embodiments of the invention so that persons skilled in the art are enabled to use the invention. The claims, on the other hand, define the scope of the invention, are the things evaluated against the prior art when determining whether an invention is "novel," and are the measure of whether future devices or methods infringe upon the patent. Claims can and typically do exceed the scope of the particular embodiments in the specification, which are simply examples of the invention. The questions presented by this Petition are:

1. Whether the Federal Circuit erred by importing into a patent claim various limits implied from the specification, thereby improperly limiting the scope of literal infringement and infringement under the doctrine of equivalents?

2. Whether the Federal Circuit improperly restricted the claim scope of a pioneer patent, and the range of equivalents that can fall within that patent's claim, by importing into the claim various limits implied from the specification, thereby undermining the expansive claim construction and broad range of equivalents applicable to pioneer patents?

PARTIES TO THE PROCEEDINGS BELOW

Plaintiff/Appellant in the courts below was the current Petitioner, Arlaine & Gina Rockey, Inc. ("AGR"). AGR has no parent corporations, and no publicly held corporation owns more than 10% of AGR's stock.

Defendant/Appellee in the courts below was Respondent Cordis Corporation.

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PETITION FOR WRIT OF CERTIORARI

Petitioner respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The initial order of the district court construing the relevant terms of the patent claim is unpublished and is reproduced herein as Appendix B (pages B1-B96). The amended order of the district court reconsidering its initial order and changing the court's construction of the relevant terms of the patent claim is unpublished and is reproduced herein as Appendix C (pages C1-C96). The order of the district court denying reconsideration of its amended order and granting summary judgment for defendant is unpublished and is repro-

duced herein as Appendix D (pages D1-D13). The decision of the Federal Circuit affirming summary judgment is unpublished, but reported at 175 Fed. Appx. 329, 2006 WL 678921, and is reproduced herein as Appendix A (pages A1-A9). The Federal Circuit's denial of rehearing is unpublished and is reproduced herein as Appendix E (page E1).

JURISDICTION

The Federal Circuit issued its opinion on March 16, 2006 and denied rehearing on April 11, 2006. The Chief Justice granted Petitioner an extension of time to file this Petition through September 8, 2006. This Court has jurisdiction to hear this Petition pursuant to 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

The Patent Act provides, in relevant part:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. The specification shall conclude with *one or more claims* particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. * * *

35 U.S.C. § 112 (emphasis added).

STATEMENT OF THE CASE[1]

1. Petitioner Arlaine & Gina Rockey, Inc. ("AGR"), is the holder of several patents issued to Dr. Arthur G. Rockey

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[1] Unless otherwise noted, the facts are taken from the Federal Circuit opinion, attached hereto as Appendix A, and from the district court's amended order, attached hereto as Appendix C.

and subsequently assigned to AGR. The Rockey patents involve devices and methods of treating blood vessels and parts of the gastrointestinal tract with medical devices called stents.[2] The patent at issue in this case, U.S. Patent No. 4,641,653 (the " '653 patent"), involves a pioneering method of inserting a stent, referred to as a "sleeve" by the patent, into a vessel to be treated, and is now the standard of care for treating blocked or collapsed blood vessels.

As relevant to this litigation, Claim 2 of the '653 patent involves a method for inserting a stent (sleeve) into a blood vessel, manipulating the stent into position, and expanding it with a balloon outward toward the walls of the vessel.[3] The stent thereafter remains in place and helps to maintain an open passageway in a diseased vessel. Claim 2 of the '653 patent describes the invention as follows:

> 2. A method of treating an area of a body vessel, comprising the steps of: [1] introducing a catheter with a collapsed inflatable balloon and a collapsed sleeve encircling the balloon on its end into the vessel at a point remote from the area to be treated; [2] manipulating the

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[2] Stents or "sleeves" are hollow, tube-like structures that allow the passage of fluids while isolating, supporting, or expanding the body vessels into which they are inserted and through which such fluids normally flow. App. F4. The use of balloon-expandable stents is now the standard and preferred alternative to balloon angioplasty or coronary artery bypass surgery for treating blocked arteries. *Cf.* Charles Lane, *Justice Kennedy Has Stent Implanted*, Washington Post, Sept. 6, 2006, at A8 (quoting this Court describing stent implant procedure as "routine").

[3] Petitioner maintains that Dr. Rockey's '653 Patent is the first or "pioneer" patent identifying a method for the use of balloon-expandable stents in this fashion. Cordis claims that the method was invented by others and challenged the validity of the '653 patent. The district court recognized the dispute over who pioneered the method in question and denied summary judgment on that issue. App. C6, C86. In reviewing the grant and affirmance of summary judgment in this case, it must be assumed that AGR will be able to establish before a jury that Dr. Rockey was the pioneer inventor of this method and that the '653 patent is valid.

> catheter axially along the vessel to cause the balloon and sleeve to enter the area to be treated; [3] inflating the balloon by introducing fluid under pressure into the balloon through a tube of the catheter in a manner wherein the sleeve surrounding the balloon is radially expanded towards the wall of the vessel; [4] *providing in the sleeve a material which increases in rigidity after expansion of said balloon*; [5] maintaining said balloon in an expanded condition in the vessel while said sleeve increases in rigidity; and [6] thereafter removing the balloon and catheter from the vessel and allowing the sleeve to remain in place in the area to be treated.

App. F14 (bracketed numbers and emphasis added).

The preferred embodiment in the specification of the '653 Patent illustrates, *inter alia*, the use of a stent that contains a slowly-hardening substance.[4] In one embodiment this is a gel that cross-polymerizes and slowly increases in rigidity, until it sets in a semi-rigid state that keeps the stent open and in place after the balloon that expanded it is withdrawn. App. F12-F13. After describing various embodiments, and before setting forth the claims, the '653 Patent specifically rejects the notion that its invention is limited to the scope of the embodiments described:

> The invention is not restricted to the slavish imitation of each and every detail set forth above. Obviously, devices may be provided which change, eliminate, or add certain specific details without departing from the scope of the invention.

App. F13.

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[4] As noted in the Questions Presented, the "specification" sets forth one or more embodiments of the invention so that persons skilled in the relevant art are enabled to practice the invention. "Claims" define the scope of the invention, may be broader than the embodiments in the specification, and are the measure against which allegedly infringing devices or methods are measured.

2. In 1995, AGR granted Cordis an exclusive world-wide license to the Rockey Patents, which included, *inter alia*, the right to sell devices, the right of which to use, make, or sell is protected by the '653 Patent's method claims. As compensation, Cordis agreed to pay AGR a pre-paid royalty of two-million dollars and a 10% royalty on all related products sold exceeding twenty-million dollars. The dispute in this case arose when Cordis began selling the several accused devices, collectively referred to here as the Palmaz-Schatz stents, without paying royalties on them under the license agreement.

The Palmaz-Schatz stents are lattice-like steel cylinders that are delivered to a desired location within the blood vessel and then radially expanded by an internal balloon. The expanding balloon causes plastic deformation of the latticed-steel cylinder. The metal of the stent becomes more rigid in its new formation and retains its new shape after expansion and removal of the balloon. While the method for introducing and expanding the Palmaz-Schatz stents is the same as described in the '653 Patent, the primary dispute in this case is whether the variation in the material of the stent – deformable steel as opposed to a polymer with a slowly hardening gel as described in the specification – avoids infringement of the fourth claim element requiring "providing in the sleeve a material which increases in rigidity after expansion of said balloon." [5]

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[5] The Questions Presented in this Petition also bear on the construction given to other elements of the claim but which were not the basis for summary judgment, for example, the implied limitation on the definition of "sleeve" as something capable of "isolating" a vessel from the fluid that runs through it, as opposed to the more inclusive definition of a device capable of one or more of the functions of isolating, reinforcing, *or* expanding a vessel, as described in the specification. *Compare* App. C65 (defining "sleeve" to require it to perform isolating function) *with* App. F11 (describing functions of sleeve in the alternative as "expansion, reinforcement, isolation, or like treatment," with isolation being only one possible, not required, function). Although the district court's other claim construction errors would be impacted by a favorable decision from this

3. On July 1, 2002, AGR filed this action in state court in Florida, alleging, *inter alia*, breach of the licensing agreement based on Cordis's failure to pay royalties for sales of the Palmaz-Schatz stents.[6] The case was removed to the federal District Court for the Southern District of Florida.[7]

The central issue under the licensing agreement is whether the use of the Palmaz-Schatz stents infringe upon the '653 patent, thus requiring Cordis to pay the more than $300 million in royalties on the sale of those stents. The first step in resolving the question of infringement is to construe the relevant patent claims in order to define the scope of the patented method. The second step is to compare the claim, as construed, to the allegedly infringing method or device. Claim construction is a matter of law to be determined by the court. *See Markman* v. *Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996). The comparison of the challenged method or device to the claims is a question of fact generally to be determined by a jury.

The district court conducted a *Markman* hearing and issued two claim construction orders.

4. On January 5, 2004, in its initial claim construction order, the district court construed, *inter alia*, the phrase "providing in the sleeve a material which increases in rigidity after expansion of said balloon," denominated as step [4] of Claim

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Court on the proper standards of claim construction, because those errors were not the basis for the judgment below or the decision on appeal, they would best be reconsidered on remand under any new standards set forth by this Court in connection with the construction of the "providing in" language.

[6] The Complaint raised two other claims that are no longer at issue in this Petition.

[7] That removal was the subject of an interlocutory petition for review, which was denied and is no longer at issue in this Petition. *See Arlaine & Gina Rockey, Inc.* v. *Cordis Corp.*, 68 Fed. Appx. 185 (CA Fed. 2003).

2 of the '653 Patent, and adopted a broad construction that would readily encompass Respondent's Palmaz-Schatz stents.

The court began its analysis by duly noting a plethora of standards for claim construction, including the requirements that: claims are construed according to "the ordinary and customary meanings attributed to the words used" as the terms would be understood by persons skilled in the relevant art; the ordinary meaning of a claim term begins with "[s]tandard dictionaries of the English language"; "there is a heavy presumption that" the ordinary and customary meanings of terms "are the proper meanings"; the ordinary and customary meaning should be considered in light of the "rest of the intrinsic evidence, including the patent specification and file history" in order to determine "which of the different possible dictionary meanings of the claim terms in issue is 'most consistent with the use of the words by the inventor'"; "'claims must be read in view of the specification, * * * but limitations from the specification are not to be read into the claims'"; "[c]laims should be construed to encompass all definitions that are consistent with the use of the word in the intrinsic record, except those that have been disclaimed"; it is generally improper to rely on extrinsic evidence where the intrinsic evidence resolves any dispute or ambiguity; and the court may only depart from the ordinary and customary meaning where the patentee "has chosen to be his or her own lexicographer by clearly setting forth an explicit definition for a claim term" or where the terms chosen are so unclear as to make it impossible to determine the scope of the claim therefrom. App. B49-B52 (citations omitted).

The Court then turned to an analysis of the various phrases in Claim 2 of the '653 patent. Regarding the phrase "providing in the sleeve a material which increases in rigidity after expansion of said balloon," the court recognized the variety of competing definitions offered by the parties for the words "providing" and "in." App. B70-71. Respondent proposed to define "provide" to mean "'to supply or make avail-

able; to make something available to' (Webster's Ninth)" and to define the word "in" to mean 'indicate[s] location in space or in some materially bounded object.' (Webster's Third)." App. B70.

Petitioner offered a variety of dictionary definitions of "provide" that were consistent with Claim 2, including "(1) 'to make available;' or 'to supply; to afford' (Webster's Twentieth); (2) 'to furnish, supply, or equip;' 'to afford or yield;' or 'to prepare or procure beforehand (the latter being referred to as an "archaic" meaning)' (Random House); and (3) 'to make preparation to meet a need;' or 'to supply or make available' (Webster's Ninth)." App. B70-71.

For the word "in," Petitioner likewise offered a variety of dictionary definitions, including "(1) 'contained or enclosed by, inside; within;' or 'amidst; surrounded by;' or 'into;' or 'limited by the scope of' ('as, in my opinion'); 'so as to form' ('as, arranged in curls'); * * * (3) 'used to indicate inclusion within space, a place or limits;' or 'on the inside; within' * * * (5) 'by means of, with (written in pencil)'; * * *; and (6) 'existing as a part, characteristic, or property of (in the works of Shaw);' or 'made of a specified color, style or material.'" App. B70-B71 (citations omitted).

Petitioner's definitions both included and exceeded Respondent's definitions, allowing the relevant "material" to be made available as a "part" or "property" of the stent itself *or* to be supplied separately "into" the stent. Petitioner's definition thus was not so much inconsistent with Respondent's definition; it was merely *broader* than Respondent's definition.

Addressing Respondent's argument that one embodiment of the invention described in the specification involves the addition of a *separate* material *into* a space within the sleeve, the court responded that "this is a description of just one of the disclosed embodiments. It is merely one way that a material may be 'provided in' the sleeve." App. B71. The court

found support for its position in a description of one embodiment in the specification of a "sleeve unit" that includes hollow filaments that "'may be made of the **same or similar material as the sheath [*i.e.*, sleeve],**'" but that "does not describe any separate material that is added to the sleeve unit to increase its rigidity." App. B71-72 (emphasis added by court). The court further observed that the next step [5] in Claim 2 regarding "maintaining said balloon in an expanded condition in the vessel while said **sleeve increases in rigidity**" only required that the "sleeve" increase in rigidity, thereby drawing an equivalence between the "sleeve" in step [5] and the "material" that increases in rigidity in step [4]. App. B72. The court concluded from its examples that "adding to the sleeve a separate and distinct material that increases in rigidity * * * is not essential to [Dr. Rockey's] invention," notwithstanding that adding such a separate material constitutes *one* embodiment, or one means, for practicing the invention. App. B71-B72.

The court thus concluded by adopting one of the broader definitions offered by AGR and held that "the claim construction of the phrase "providing in the sleeve a material" that is most consistent with the intrinsic record is: *to make available as a part or property of the sleeve itself, or to supply into the sleeve, a material.*" App. B72 (emphasis in original).

Applying the claim, as construed, to Respondent's challenged stents, the court held that there were material issues of fact as to whether the stents satisfied the terms of the claims, including the "providing in the sleeve a material" aspect of the claim, and thus denied Respondent's motion for summary judgment. App. B78. Regarding Respondent's effort to prevent Petitioner from relying on the doctrine of equivalents to show infringement, the court observed that there was sufficient evidence and expert testimony to allow the doctrine of equivalents issue to go to the jury. App. B81 (describing expert testimony "that a stent made of stainless steel, which is plastically deformed during expansion, functions in substan-

tially the same way to achieve substantially the same result, as a stent made by a polymer which undergoes polymerization and hardening upon expansion"); App. B83 (describing expert testimony that it was merely an "insubstantial difference" that "the material in a polymer stent is a polymer and the material in the Cordis stents is 316L stainless steel, both of which nonetheless share the physical property of increasing in rigidity after expansion of the balloon.").

Finally, the court recognized – in the context of a challenge to the '653 patent's validity – a dispute regarding who originally invented the method for inserting balloon expandable stents, to the extent the method is deemed to cover metal stents. After noting various facts relevant to that issue, the court concluded that "there are remaining factual disputes regarding who invented the subject matter, *i.e.*, balloon-expandable metal stents, first." App. B85.

Cordis sought reconsideration of various portions of that ruling.

5. On March 11, 2004, the district court granted Cordis's motion for reconsideration and issued an amended claim construction order. That order was substantially the same as the initial order on most issues, with the main exception being the court's construction of the "providing in" element of Claim 2. On that issue, the court effectively reversed itself and adopted the narrower construction advocated by Cordis, requiring that the language "providing in the sleeve a material" be read to mean "*to supply in the sleeve a material that is separate and distinct from the sleeve itself.*" App. C73 (emphasis in original).

The court once again began with an identical recitation of the numerous standards regarding claim construction. App. C49-C53. It likewise recounted the same proposed dictionary definitions it had reviewed in its first order. App. C70-C72. But then the court's analysis diverged from its earlier reasoning.

Addressing the only additional embodiment added to the specification by the '653 Patent, the court noted, that the embodiment used a separate material added to the sleeve to create rigidity after expansion. This time, however, rather than treat the embodiment as merely one possible example of how to meet the "providing in" element, the court treated that embodiment as limiting the claimed invention to the addition of a separate and distinct material. App. C72. And this time the court ignored its previously cited support for a more encompassing definition and instead contrasted language in the specification in connection with a different embodiment of the invention, which stated that the sleeve **"is preferably formed of** relatively inelastic material or otherwise is circumferentially reinforced with inelastic material along its length so that the pressure of blood flowing through the sleeve is effectively isolated from the vessel." *Id.* Through that example, the court inferred that the choice in Claim 2 of the words "providing in" as opposed to the words "formed of" in the earlier embodiment implied that "the definition of "providing in" must somehow be *exclusive* of the concept of being "formed of," rather than simply a *broader* phrase that encompasses *both* concepts of adding material to the sleeve *and/or* forming the sleeve out of a material that would increase in rigidity, such that either approach would satisfy the claim element.

While the court thereafter perfunctorily recognized "that claims may be broader than any of the disclosed embodiment(s)," it nonetheless construed the phrase "providing in the sleeve a material" to mean "*to supply in the sleeve a material that is separate and distinct from the sleeve itself.*" App. C72-C73

Even under the narrower definition, however, the court reiterated its earlier findings that there were issues of fact that precluded summary judgment regarding literal infringement, the doctrine of equivalents, and the issue of "who invented

the subject matter, *i.e.*, balloon-expandable metal stents, first." App. C79, C82-C86.

AGR then filed a motion for reconsideration of the claim construction while Cordis renewed its motion for summary judgment.

6. On January 24, 2005, the district court denied AGR's motion for reconsideration of the claim construction and granted summary judgment in favor of Cordis. Based on the narrower claim construction in the amended order, the district court found that the use of the Palmaz-Schatz stents does not infringe the '653 Patent and that therefore no additional royalties were due to AGR pursuant to the license.

The court initially reiterated its claim construction of the "providing in" language and denied AGR's motion for reconsideration and return to the court's original construction of that phrase. App. D2. It then found that there was no literal infringement because the "change in the characteristics of the 316L stainless steel contained in the Cordis stent is not the addition of a material '*separate and distinct from the [stent] itself.*'" App. D10.

Regarding infringement under the doctrine of equivalents, the court recited the commonly used test of "'whether the accused product performs the same function, in the same way, with the same result,'" and concluded that "the accused Cordis stent simply does not perform the same function in the same way as the Rockey patent" because it "does not provide a material in its balloon expandable stents other than the stent itself," as required by the court's claim construction. App. D12-13 (citation omitted). The court thus concluded that a "finding of infringement under the doctrine of equivalents here would vitiate the requirement of a material '*separate and*

distinct from the sleeve itself' which is '*added to the sleeve.*'" App. D13.[8]

AGR appealed to the Federal Circuit.

7. On March 16, 2006, the Federal Circuit affirmed. The court began with a recitation of the requirement to "first consider the ordinary and customary meaning of the claim language." To that requirement, however, the court added the further gloss, from its recent decision in *Phillips* v. *AWH Corp.*, 415 F.3d 1303, 1312-13 (CA Fed. 2005) (*en banc*), that a "claim's "ordinary and customary meaning" is the reading a person of ordinary skill in the art would give the claim at the time of the invention," and that "the person of ordinary skill in the art should read the claim term 'not only in the context of the particular claim in which the disputed terms appears, but in the context of the entire patent, including the specification.'" App. A5-A6. That gloss thus signaled the manner in which the court was going to avoid the prohibition against importing limitations from the specification into the claims: It was going to have the hypothetical "person of ordinary skill in the art" do it.

As the district court had done, the Federal Circuit then looked to the limited embodiments illustrated in the specification and limited the broader claim language to the specific approaches illustrated by the embodiments, without even considering the ordinary and customary definition of the words

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[8] The court's findings of non-infringement depend upon the singular nature of the material used to make the Palmaz-Schatz stents and the absence of a separate material serving the function of providing rigidity. That analysis would not necessarily preclude infringement through the sale of different stents that use materials in addition to the steel lattice, or that coat the steel lattice to form a multi-material product in which the steel material performs the function of maintaining rigidity while other materials perform other functions in the sleeve. Cordis has begun selling so-called "Cypher" stents having such a design, and whether those stents infringe even under the court's narrow claim construction is a separate matter not addressed below and the proper subject for a separate suit.

used. Indeed, the court looked to the narrow language describing the embodiments – which used different words such as "contain[ing]" and "introduce[ing] in reference to the material used to make the sleeve rigid – to limit the broader phrase "providing in." App. A7.[9] And, like the district court, the Federal Circuit contrasted the use of the words "formed of" in the specification and "providing in" in Claim 2 to arbitrarily infer than the latter phrase was exclusive of the former phrase, rather than simply being broader than and *inclusive* of the former phrase. App. A8. The court thus agreed "with the district court's construction of the fourth claim limitation." *Id.*

Thereafter the Federal Circuit further agreed with the district court that the Palmaz-Schatz stents did not satisfy the fourth claim element and hence did not infringe on the '653 Patent. And regarding infringement under the doctrine of equivalents, the Federal Circuit, like the district court, noted that because the accused stents did not literally infringe, they could not be found to infringe by equivalence because "the application of the doctrine of equivalents in this situation would vitiate the 'providing in' limitation." App. A8-A9.

8. AGR petitioned for rehearing, which was denied on April 11, 2006. App. E1. This petition for certiorari followed.

REASONS FOR GRANTING THE WRIT

Certiorari should be granted because the decision below reflects and illustrates the lack of consistent and predictable

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[9] Interestingly, the court quoted a part of the specification describing the "sleeve space * * * *contain[ing]* a fluid plastic material * * * which is caused to become solidified," yet argued that when Dr. Rockey "meant to convey the preexistence of a material in the sleeve he used an appropriate verb, such as 'contain[ing].'" App. A7. That analysis, of course, actually *supports* Petitioner's broader definition covering a material that would preexist in and as part of the sleeve, and contradicts the court's conclusion.

claim construction standards, which allows courts to reach inconsistent and unpredictable results. Such standards undermine fundamental principles of claim construction and the proper relationship between the claims and the specification, as occurred in this case.

I. THE DECISION BELOW REFLECTS THE CONTRADICTORY CLAIM CONSTRUCTION RULES APPLIED BY THE FEDERAL CIRCUIT, WHICH CAUSE EXTENSIVE CONFUSION AND INCONSISTENCY IN THE FEDERAL CIRCUIT AND THE DISTRICT COURTS.

The district court's and the Federal Circuit's claim construction in this case illustrates the confusion and hazards involved in the numerous and often contradictory standards adopted by the Federal Circuit for construing patent claims. By selectively choosing among different examples and descriptions in the specification, the courts below ended up importing limitations from the specification – that a *separate and distinct* material had to be *added* to the sleeve – that are nowhere present in Claim 2 itself. That result violated the cardinal rule that specifications teach and claims claim, and that descriptions of the embodiments set forth in the specifications may not be used to imply limitation on the otherwise ordinary meaning of the claims. *Rexnord Corp.* v. *Laitram Corp.*, 274 F.3d 1336, 1344 (CA Fed. 2001). Rather, claims may be broader than the embodiments in the specification, and "[i]f more than one dictionary definition is consistent with the use of the words in the intrinsic record, the claim may be construed to encompass all consistent meanings." *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1300 (CA Fed. 2003). Indeed, as this Court has noted,

> we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in the claim in order to

> limit such claim * * *, we should never know where to stop.

McCarty v. Lehigh Valley R.R., 160 U.S. 110, 116 (1895).

That the courts below violated these basic rules under the guise of simply *construing* the claim language is no excuse, and in fact illustrates the amorphous and inconsistent nature of the rules governing claim construction. Indeed, even after the district court determined that the ordinary and customary meaning of the phrase "providing in the sleeve a material" was the broader definition of "*to make available as a part or property of the sleeve itself, or to supply into the sleeve, a material*," App. B72 (emphasis in original), which definition encompassed both the addition of *and* the formation from a material that increases in rigidity, the courts below were able to rely on examples from the specifications that were entirely consistent with that definition, but which only embodied one aspect of the definition, to limit the definition to the narrower aspect embodied in the specification, notwithstanding the broader language of the claim.

That exercise does not constitute a genuine search for the ordinary and customary meanings of the claim terms, but rather a results-based unwillingness to have the claims exceed the scope of the embodiments in the specification. This case thus well illustrates the malleability and lack of predictability of the current open-ended palette of claim construction standards, and the need for this Court to step in to reinforce and prioritized the core rules of claim construction.

A. There Is Confusion and Inconsistency Regarding the Use of the Specification To Limit Patent Claims.

The continuing confusion over whether and when claims may be limited by the embodiments included in the specification is exemplified by two recent Federal Circuit cases reaching opposite results on comparable facts: *LizardTech, Inc.* v. *Earth Resource Mapping, Inc.*, 424 F.3d 1336 (CA Fed.

2005), *reh'g en banc denied*, 433 F.3d 1373 (CA Fed. 2006), and *JVW Enterprises* v. *Interact Accessories*, 424 F.3d 1324 (CA Fed. 2005).

In *LizardTech* the Federal Circuit affirmed a finding of no infringement and patent invalidity relating to a method of eliminating artifacts generated by compressing digital image data. 424 F.3d at 1337. The panel oddly read some limitations from the specification into one of the claims, refused to read another limitation into the claim, and then invalidated the claim because, as partially narrowed, it remained broader than the description in the specification and hence failed the written description rule. *Id.* at 1344, 1346 (citing *Phillips*, 415 F.3d at 1321, for the proposition that "claims cover only the invented subject matter"). The Federal Circuit denied rehearing *en banc*, but produced concurring and dissenting opinions regarding such denial, which illustrate the inconsistent state of the law. *LizardTech*, 433 F.3d at 1374, 1376 (Lourie, J., concurring; Rader, J., dissenting).

In *JVW*, by contrast, the Federal Circuit reversed a finding of non-infringement for a variation on a video-game steering wheel controller and held that it "would be improper" to "limit claim language to the specific embodiment disclosed in the written description." 424 F.3d at 1335. "We do not import limitations into claims from examples or embodiments appearing only in a patent's written description, even when a specification describes very specific embodiments of the invention or even describes only a single embodiment, unless the specification makes clear that 'the patentee * * * intends for the claims and the embodiments in the specification to be strictly coextensive.'" *Id.* (citing *Phillips*, 415 F.3d at 1323).

In the dissent from the denial of rehearing *en banc* in *Lizardtech*, Judges Rader and Gajarsa noted the disparate results between *LizardTech* and *JVW*, decided only one day apart, and decried the contradictory state of Federal Circuit law regarding whether and when otherwise broad claims will be

narrowed to the scope of the embodiments in the specification.

As explained by the dissent, both cases "confront an issue common to many patent disputes: claims that are broader than the disclosed embodiments." 433 F.3d at 1376 (Rader, J., dissenting). But the two cases apply squarely opposite presumptions regarding the interaction between the specification and the claims. "[A]ccording to *Lizardtech*, claims should not be broader than the disclosed embodiments unless the specification suggests the invention is broader than those embodiments," creating "a presumption [that] claims must be commensurate in scope with the preferred embodiments absent language suggesting otherwise." *Id.* at 1376-77. *JVW*, by contrast, creates an alternate "presumption: claims need not be commensurate in scope with the preferred embodiments absent language suggesting otherwise." *Id.* at 1377.

The dissenting Judges in *LizardTech* sided with the approach in *JVW*, which allows claims broader than the embodiments in the specification and noted that the court in *LizardTech* "has not explained the standard that makes these claims 'expansive' and invalid as opposed to merely broader than the enabling embodiment." *Id.* at 1381. The dissent noted, unfortunately, that because the similarity between *LizardTech* and *JVW* "stand in stark contrast to [their] disparate outcomes * * *, these next-door neighbors in West's Federal Reporter must leave practitioners in a quandary." *Id.* at 1376.

Numerous other cases from the Federal Circuit likewise illustrate the inconsistent standards used in deciding what limits, if any, may be imported from the specification into the claims.

On the one side are cases that emphatically defend the proposition that limitations from the specification may not be imported into the claims. *See, e.g., Gemstar-TV Guide Int'l, Inc.* v. *ITC*, 383 F.3d 1352, 1366 (CA Fed. 2004) (rejecting a claim construction limitation imported from the specification

and stating that "[o]ur precedent has emphasized that the disclosure in the written description of a single embodiment does not limit the claimed invention to the features described in the disclosed embodiment"; discussion of an innovative element of the invention in the preferred embodiment "was not a disavowal or disclaimer indicating that the claims excluded all or part of the properties of" other forms of that element); *Liebel-Flarsheim Co.* v. *Medrad, Inc.*, 358 F.3d 898, 906 (CA Fed.) (rejecting argument that claim must be limited because each embodiment in the specification contained the same limiting feature and noting that "this court has expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment"), *cert. denied*, 543 U.S. 925 (2004); *Teleflex, Inc.* v. *Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (CA Fed. 2002) (refusing to limit claim term to embodiment example because ordinary and customary meaning controls unless patentee redefines the term or characterizes the invention "in the intrinsic record using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope"); *Rexnord*, 274 F.3d at 1343 (construing the ordinary meaning of the claim term "portion" as including "two possible readings – parts that were 'separable from the whole' and parts that were 'not separated from the whole'" and reversing the district court's reliance on the use of separable parts in the specification to limit the claim term to such separable parts thereby denying the term "the full range of its ordinary meaning (which would encompass both readings)"; "Our case law is clear that an applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention.").[10]

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[10] *See also, Comark Communications, Inc.* v. *Harris Corp.*, 156 F.3d 1182, 1186-87 (CA Fed. 1998) (rejecting an attempt to read a limitation into a claim based on the manner in which the preferred embodiment functions); *E.I. du Pont de Nemours & Co.* v. *Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (CA Fed.) ("It is entirely proper to use the specification to

By refusing to import limitations from the specification into the claims, these cases comport with the broader rule of construction that "[i]f more than one dictionary definition is consistent with the use of the words in the intrinsic record, the claim may be construed to encompass all consistent meanings." *Brookhill-Wilk*, 334 F.3d at 1300; *see Texas Digital Sys., Inc.* v. *Telegenix, Inc.*, 308 F.3d 1193, 1203 (CA Fed. 2002) (same); *Johnson Worldwide Assocs., Inc.* v. *Zebco Corp.*, 175 F.3d 985, 989 (CA Fed. 1999) ("General descriptive terms will ordinarily be given their full meaning; modifiers will not be added to broad terms standing alone. * * * In short, a court must presume that the terms in the claim mean what they say, and, unless otherwise compelled, give full effect to the ordinary and accustomed meaning of claim terms."). The fact that embodiments in a specification may only illustrate a limited sense of a claim's ordinary and customary meaning is simply no justification for limiting the meaning to that one sense and discarding other consistent definitions that happen to be broader than – though not inconsistent with – the specification.

On the other side of the claim construction divide are cases readily doing exactly that which the first group says is forbidden: importing limitations from the specification into the claims. *See, e.g., Invitrogen Corp.* v. *Biocrest Mfg., L.P.*, 327 F.3d 1364, 1367 (CA Fed. 2003) ("The applicant may

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interpret what the patentee meant by a word or phrase in the claim. * * * But this is not to be confused with adding an extraneous limitation appearing in the specification, which is improper") (citation omitted), *cert. denied*, 488 U.S. 986 (1988); *Specialty Composites* v. *Cabot Corp.*, 845 F.2d 981, 987 (CA Fed. 1988) ("Where a specification does not *require* a limitation, that limitation should not be read from the specification into the claims.") (emphasis in original); *Lemelson* v. *United States*, 752 F.2d 1538, 1552 (CA Fed. 1985) ("[N]owhere does the specification *require* automatic prepositioning * * * Even if the specification only discloses apparatus directed to executing automatic prepositioning * * *, this does not dictate reading such a limitation into the prepositioning step of the claim.") (emphasis in original).

also act as his own lexicographer and use the specification to *implicitly* or explicitly supply new meanings for terms.") (emphasis added); *Bell Atlantic Network Servs., Inc.* v. *Covad Communications Group, Inc.*, 262 F.3d 1258, 1268, 1273 (CA Fed. 2001) ("the specification may define claim terms 'by implication'"; giving lip-service to the rule against importing limits by "inferences drawn from the description of a preferred embodiment" and then doing precisely that by holding that "the patentees defined the term 'mode' by implication, through the term's consistent use throughout the '786 patent specification" and limiting the claim to the modes described in the preferred embodiment) (citation omitted); *Toro Co.* v. *White Consol. Indus., Inc.*, 199 F.3d 1295, 1300-01 (CA Fed. 1999) (claim term interpreted as limited to the embodiments in the specification, which showed only one particular structure); *Wang Laboratories, Inc.* v. *America Online, Inc.*, 197 F.3d 1377, 1383 (CA Fed. 1999) ("The only embodiment described in the '669 patent specification is the character-based protocol, and the claims were correctly interpreted as limited thereto.").

The Federal Circuit itself has recognized the difficulties these cases present for the rule that claim limitations are not to be imported from the specification. *Texas Digital*, 308 F.3d at 1205 (noting that despite the rule that a claim is not limited to the embodiment in the specification, "one can easily be misled to believe that this is precisely what our precedent requires when it informs that disputed claim terms should be construed in light of the intrinsic record") (citing cases). Indeed, even the recent *Phillips* case, which was taken *en banc* to try to address claim construction difficulties, recognized that "the purpose underlying the *Texas Digital* line of cases – to avoid the danger of reading limitations from the specification into the claim – is sound" and that "the distinction between using the specification to interpret the meaning of a claim and importing limitations from the specification

into the claim can be a difficult one to apply in practice." 415 F.3d at 1323.

But *Phillips* ended up aggravating, rather than curing, the problems *Texas Digital* sought to avoid, by downgrading the role of dictionary definitions, calling for even more reliance on the specifications, and endorsing an open-ended search for meaning that simply invites more of the inconsistency and implied claim limitations that plagued claim construction before that *en banc* decision. *See* 415 F.3d at 1320-24.

In the end what now exists is a set of utterly contradictory claim construction rules from which a court can pick and choose to reach any desired result whatsoever. Rather than a set of rules driving results in a predictable and reliable manner, the current approach necessarily starts with whatever result the court thinks is correct – for whatever reason or for no particular reason whatsoever – and then has the court justify that result by selecting among the palette of rules regarding claim construction.

Numerous commentators likewise have recognized the incoherent state of the law regarding the interaction between claims and specifications in the context of claim construction. Prior to the Federal Circuit's *en banc Phillips* decision, a chorus of commentators had noted the utter chaos in the law. *See, e.g.*, Kimberly A. Moore, Markman *Eight Years Later: Is Claim Construction More Predictable?*, 9 LEWIS & CLARK L. REV. 231, 246-47 (2005) ("With judicial claim construction now nearing its adolescence (eight years from the Supreme Court's *Markman* and ten years from the Federal Circuit's *Markman*), there should be more predictability. The reversal rate ought to be going down, not up. The fault, at this point, undoubtedly lies with the Federal Circuit itself. The court is not providing sufficient guidance on claim construction. There have not evolved any clear canons of claim construction to aid district court judges, and in fact the Federal Circuit judges seem to disagree among themselves regarding the tools available for claim construction."); Gregory

J. Gallagher, *The Federal Circuit and Claim Construction: Resolving the Conflict between the Claims and the Written Description*, 4 N.C. J.L. & TECH. 121, 122-23 (2002) ("the claim construction process has been far from clear, and, as a result, the amount of litigation regarding claim construction is voluminous.[] At the center of the difficulty in construing claims is the Federal Circuit's use of two apparently conflicting canons of construction with regard to the relationship between the claims and the written description" – do not import limitations from the specification and read the claim in light of the specification; "The Federal Circuit has struggled to reconcile these seemingly conflicting canons and articulate how to read a claim in view of the specification without reading limitations into the claim."); Russell B. Hill & Frank P. Cote, *Ending the Federal Circuit Crapshoot: Emphasizing the Plain Meaning in Patent Claim Interpretation*, 42 IDEA 1, 2 (2002) ("The Federal Circuit continues to issue panel-specific contradictory decisions regarding the respective roles of the plain meaning of patent claim terms and the written description in patent claim interpretation.[] The resulting uncertainty encourages wasteful litigation and saps judicial resources.") (footnote omitted).

The Federal Circuit took the *Phillips* case in part to try to resolve some of that chaos, but instead simply made it worse, as described above and as the *LizardTech* dissent illustrates. Commentators have continued to decry the sad state of claim construction. *See* Scott A. Turk, *The Proper Method for Using Dictionaries to Construe Patent Claims*, 6 CHI.-KENT J. INTELL. PROP. 43, 64-65 (2006) (noting confusion regarding the use of dictionary definitions to define claim terms where "many of the courts, including the CAFC, applied different standards in different cases"; and observing that *Phillips* demoted the role of dictionaries relative to looking to the specification, to the detriment of claim definiteness); Joseph Mueller, *Case Focus: Of Words and Patents*, 49 BOSTON B.J. 6, 7 (2005) ("But the debate over dictionaries, and, more gener-

ally, intrinsic evidence versus extrinsic evidence, is a reflection of a deeper issue as to which *Phillips* left considerable ambiguity: the relationship between the claims and the written description. * * * Until the relationship between the claims and the written description is resolved in a clear fashion, patent lawyers will continue to struggle with how to interpret the words in a patent.").

Even worse than with a split in the circuits in other areas of the law, the inconsistent standards in the Federal Circuit place claim construction in any given case at the mercy of chance and changing judicial inclination, and allow district courts and the Federal Circuit to support virtually any result by selectively emphasizing different standards of construction to justify importing or rejecting implied limits from the specification. That inconsistency is as untenable as any circuit split.

B. The Proper Relationship Between Claim Construction and the Specification Is an Important Issue that Has Significant Implications for Patents and Patent Law.

The issues presented in this Petition are of national importance and should be addressed by this Court for a variety of reasons. Initially, such a basic issue as claim construction arises in almost every patent case and affects every patent even before litigation arises. The availability of numerous implied exceptions to the otherwise ordinary meaning of claim terms tends to encourage infringement of patents, prompts more litigation, and makes the results of such litigation more and more uncertain. At a minimum, it undermines the incentives for using the patent system as a means of encouraging and disseminating invention by making the reward for filing a patent speculative and difficult to reap. And with regard to patents that are filed, tremendous economic consequences ride on the construction of claims, with patent disputes often involving hundreds of millions of dollars or more. Indeed, this case alone involves $300 million in dispute, and

patent disputes in larger industries such as computers and communications likely involve far more.

Furthermore, clarity and coherence in the standards applied to claim construction – and specifically in the rule regarding the effect of the specification on the scope of the claims made – are especially important given the numerous patent law issues affected by this aspect of claim construction. For example, determining whether the claims exceed or are limited by the specification affects at least three subsequent determinations in patent litigation.

First, and most directly, claim limits imported from the specification affect the determination of literal infringement, by narrowing the scope of the claims and hence making it easier for a defendant to avoid infringement by deviating from the thus-narrowed claims. Just such an effect occurred in this case.

Second, limiting the claims through the specification constricts the scope of infringement under the doctrine of equivalents by reducing the range of equivalents and excluding equivalents that differ from the specification even though they would be equivalent under a broader reading of the claim. Indeed, the way this is done is effectively to create an estoppel against equivalents that might satisfy the claim itself, but that do not satisfy the specification, claiming that such equivalents would vitiate an implied element of the claim. Again, just such an effect occurred in this case.

Third, the proper relationship between the specification and the claim affects the determination of whether the written description is valid as sufficiently describing the invention and the means to practice it, as required under § 112. That was the issue in *LizardTech*, and the dissent there noted the necessary dependence of that issue on claim construction rules. 433 F.3d at 1377 n. 1 (Rader, J., dissenting) ("Of course, this analysis only proves that the written description invalidity doctrine is really a claim construction invalidity

doctrine."). A clear ruling from this Court that claims need not and should not be limited to the embodiments in the specification would thus also help clarify that such claims are not therefore invalid by *not* being limited to the embodiments in the specification.

In sum, the fundamental first step of claim construction and the proper relationship of the claim to the specification have multiple downstream effects that impact not only determinations of infringement but determinations of patent validity itself, making the Questions Presented in this case ones of tremendous and recurring importance.

II. ADOPTING A PROPER AND CONSISTENT APPROACH TO CLAIM CONSTRUCTION WOULD ALLEVIATE THE INCOHERENT AND ARBITRARY RESULTS IN THE COURTS BELOW AND WOULD REQUIRE AN OPPOSITE RESULT IN THIS CASE.

A good deal of the inconsistency and arbitrariness surrounding claim construction can be alleviated by this Court reaffirming and prioritizing certain central cannons of construction and providing a uniform methodology for claim construction. Because claims should be judged first and foremost by the actual language they use, this Court should endorse a plain-meaning approach utilizing standard dictionaries or reference works to define the ordinary and customary meanings of the words in a claim. That initial step is especially useful where claims use ordinary English words, rather than highly technical or novel terms of art, to define the scope of the invention. Absent *express* redefinition in the specification of such ordinary words, courts should presume that the words carry their usual meaning even to persons skilled in a particular art, and should not go searching for some *implied* or functional redefinition or limitation of the words in the mere examples of the embodiments contained in the specification. The words of the claim should be given the full breadth of all compatible meanings, and the fact that the pre-

ferred embodiments may only illustrate *part* of a broadly inclusive definition should not be allowed to support a conclusion that other parts of the definition are thus excluded where such other parts are not *incompatible* with the embodiments but simply cover *alternatives* to those preferred embodiments.

While the specification can indeed be useful in claim construction where it also uses the *same* words as the claim, the primary function of the specification in claim construction should be to ensure that the plain and ordinary meanings ascribed to claim terms do not yield inconsistent or incompatible results when such meanings are applied to the use of such terms in the specification. To avoid the cardinal sin of importing limitations from the specification into the claims, determinations of incompatibility between the ordinary meaning of claim terms and the specification should be limited to actual conflicts with the ordinary definitions or *express* limitations on the definitions of particular words or *express* disavowal of claim scope. A determination of incompatibility should not include conflicts or limitations implied from the inevitably narrower nature of the *examples* serving as preferred embodiments in the specification.

Finally, in the case of pioneer patents, which claim inventions that do not have a large well of prior art to avoid, thus are less constrained by novelty concerns, and form the font for an undoubted array of improvements which would themselves be patentable even while practicing on the underlying patent, courts should be especially diligent in giving claims their full breadth and avoiding implied limits, both in connection with the construction of the claims themselves and in the range of equivalents available thereunder.[11]

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[11] *See, Warner-Jenkinson Co.* v. *Hilton Davis Chemical*, 520 U.S. 17, 27 n.4 (1997); *Smith* v. *Snow*, 294 U.S. 1, 14 (1935); *Brothers* v. *United States*, 250 U.S. 88, 89 (1919); *Singer Company* v. *Cramer*, 192 U.S. 265, 276 (1904); *The Roller Mill Patent*, 156 U.S. 261, 269 (1895); *Sessions* v.

This approach would constrain much of the open-ended and inconsistent searching for limitations in the specification that characterizes the current approach to claim construction, and would increase the predictability of the process for courts and businesses alike. *See* Hill & Cote, 42 IDEA at 24-25 ("Uniform application of the presumption in favor of plain meaning preserves the paramount role of patent claims in our system and better effectuates the Patent Act. Such uniform application reaffirms the notice function of patent claims and removes a great degree of uncertainty from the claim interpretation process."). And while it might lead to broader claim construction in various cases compared to the current approach, that is not at all a bad thing as it furthers the purposes of the patent system. Any excessive breadth in claims is checked by other mechanisms such as novelty, prior art, prosecution history estoppel, and the claims examiners at the PTO. Such mechanisms for providing proper limits on claim breadth are far preferable to the current approach of simply importing limitations from the specifications into the claims, which this Court long ago rightly observed has no stopping point. *McCarty v. Lehigh Valley R.R.*, 160 U.S. 110, 116 (1895) ("The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim * * *, we should never know where to stop.").

This case is an especially good vehicle for addressing the Questions Presented and adopting an improved methodology of claim construction in that it perfectly illustrates the effect of the current system as well as how the application of the improved system would function. Indeed, the district court *already* applied the method proposed in its original order broadly construing the "providing in" language, and its amended order and the Federal Circuit decision amply illustrate the flaws of *implying* limits from the specification.

Romadka, 145 U.S. 29, 45 (1892); *Morley Sewing Machine Co.* v. *Lancaster*, 129 U.S. 263 (1889).

For example, the narrower construction by the courts below relied upon examples from the embodiments that did not contradict the initial broad definition of the claim element, but were merely illustrative of a *part* of that definition without being exclusive of the remainder of the definition. *See supra* at 11, 14. Indeed, the Federal Circuit in *Rexnord*, a case with striking similarity to this one, identified the flaw of such implied exclusivity and illustrated the proper approach suggested here when it held that the claim term "portion" included "two possible readings – parts that were 'separable from the whole' and parts that were 'not separated from the whole'" and found that the term "would encompass both readings" notwithstanding that the specification only contained an embodiment illustrating separate parts. 274 F.3d at 1343.

Furthermore, the decisions below illustrate the improper selective reliance on different and narrower words in the specification to limit the broader language of the claim, an approach that is both illogical, leads to arbitrary results, and is contrary to the methodology proposed here. *See supra* at 11, 14; *cf.* App. C54-55 (construing the phrase "introducing * * * into" in a different claim element as meaning "*inserting or injecting*," which would seem to suggest that "providing in" has a different meaning than "introducing * * * into," but which was ignored by the court in its analysis of the "providing in" language); App. C68 (same regarding language "introducing fluid * * * into the balloon," which stands in contrast to the "providing in the sleeve a material" language).

Finally, this case illustrates a situation in which the specification was used to limit words that were entirely ordinary and not terms of art or technical words at all, and should thus have been accorded their ordinary meaning. It likewise illustrates a situation where a pioneering patent, App. C6, C86, was subjected to a claim-narrowing methodology rather than a claim expanding methodology. And it illustrates how narrowing the claim language by implication affects other issues

such as the doctrine of equivalents, application of which the courts below rejected by holding that because the alleged equivalent failed to meet the literal terms of the narrowly construed claim element it would "vitiate" that claim element if it were allowed as an equivalent. App. D13; App. A8-A9. Of course, requiring equivalents to *literally* infringe narrow claim elements essentially eliminates the doctrine entirely.

Because the outcome of this case so squarely turns on the resolution of the Questions Presented, and because this case illustrates a broad range of the problems with the current approach to claim construction, it is an excellent vehicle for this Court to employ in reaching those important questions.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

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